

Application No. 09/159,104
Amendment under 37 C.F.R. §1.111 dated November 18, 2004
Response to the Office Action of August 24, 2004

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1, 4 – 10 and 12 – 21 are pending in the present application, claims 2, 3 and 11 having been previously cancelled. Claims 5 – 10, 12 – 15 and 18 – 21 were withdrawn from consideration as being directed to a non-elected invention. Claims 1, 4, 16 and 17 have been examined in the outstanding Office Action. The rejections set forth in the Office Action are respectfully traversed below.

Claim Amendments

Claim 1 has been amended to clarify certain claim language. Specifically, claim 1, lines 8 and 9, has been amended to recite “the predetermined frequency region of said ~~region-attenuation processed~~ original sound... .” This change is consistent with lines 3 and 4 of claim 1, which recite “processing an original sound by attenuating *a predetermined frequency region of said original sound... .*” This change is also consistent with the language of original claim 3.

It is respectfully submitted that the change to claim 1 simply clarifies the claim language and does not raise new issues. Approval and entry of the changes of claim 1 are respectfully requested.

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Claim Rejections – 35 U.S.C. §102

Claims 1, 4 and 17 are rejected under 35 U.S.C. §102(e) as being anticipated by **Beller et al.** (USP 5,895,220). For the reasons set forth in detail below, this rejection is respectfully traversed.

Claims 1, 4 and 17 are rejected over the same prior art as the previous Office Action issued on March 3, 2004; however, the Examiner states that because of the amendment to claim 1, “the claim reads differently now and requires a new application of the reference” (Office Action, page 2, lines 4-5).

In rejecting claim 1, the Office Action asserts on page 3, lines 5-8:

A low pass filter attenuates signals above a cutoff frequency. Notwithstanding the cutoff frequency of the low pass filter, there exists a region above 0 Hz which is attenuated since a low frequency signal is passed. *That region is under 1800 Hz.* Therefore, *inherently*, the low pass filter of **Beller** attenuates a *region under 1800Hz* [emphasis added].

Independent claim 1 recites “processing an original sound by attenuating a predetermined frequency region of said original sound... wherein the predetermined frequency region... is ... a first region under a predetermined frequency in a *range between 1800Hz and 7000 Hz*...”

The Examiner appears to be interpreting claim 1 in a manner such that the *predetermined frequency* is a frequency in the range between 1800 Hz and 7000 Hz, and the first region is under the predetermined frequency. Therefore, for example, according to the Examiner’s apparent interpretation, if the predetermined frequency is taken as 1800 Hz (i.e., a predetermined frequency in a range between 1800 Hz and 7000 Hz), then the first region under the

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predetermined frequency is a region under (less than) 1800 Hz. The above interpretation of claim 1 is consistent with the Examiner's statement on page 3, line 8 of the Office Action "Therefore, inherently, the low pass filter of Beller attenuates a first region under 1800 Hz."

However, when reading the claims in light of the specification, claim 1 should be interpreted such that (1) the first region falls within a frequency range between 1800 Hz and 7000 Hz *and* (2) the first region is below a predetermined frequency within the frequency range between 1800 Hz and 7000 Hz.

It is respectfully submitted that **Beller et al.** do not disclose or suggest a frequency in the first frequency region.

Moreover, as noted in the previous response filed on May 20, 2004, the Examiner has supplied the claimed predetermined frequency region to the **Beller et al.** reference through an inherency argument. In other words, by asserting that the claimed predetermined frequency region is inherent in **Beller et al.**, the Examiner has admitted that **Beller et al.** do not explicitly or implicitly disclose the claimed frequency region, and takes the position that the missing frequency ranges must *necessarily* be present in the reference, and are not merely *possibly* or even *probably* present in the reference.

As pointed out in the previous response, MPEP 2163.01(a) requires "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or

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possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

However, the Examiner has not provided extrinsic evidence making clear that the missing descriptive matter is necessarily present in the reference. In fact, the following highlighted portion of the Examiner’s statement supporting the inherency argument is a conclusory statement unsupported by the **Beller et al.** reference or any extrinsic evidence: “Notwithstanding the cutoff frequency of the low pass filter, there exists a region above 0 Hz which is attenuated since a low frequency signal is passed. **That region is under 1800 Hz.** Therefore, inherently, the low pass filter of **Beller** attenuates a first region under 1800 Hz.” See Office Action, page 3, line 6-8.

A low-pass filter is generally defined as “a signal filter which passes all frequencies below a *certain frequency*, and attenuates all higher frequencies.” Clearly, various low pass filters could be designed such that the *certain frequency* below which all frequencies are passed varies. Therefore, because *various different low pass filters* can be designed having various cut off frequencies, in the absence of extrinsic evidence supporting the Examiner’s assertion, it can not be said that the low pass filter of **Beller et al.** *necessarily* attenuates any particular frequency region, such as a region under 1800hz.

Therefore, notwithstanding the Examiner’s interpretation of the claim language, in view of the failure of **Beller et al.** to disclose or suggest the claimed predetermined frequency region which is attenuated, either explicitly, implicitly or inherently, the rejection of claim 1 is unsupported by the **Beller et al.** reference. Further, each of claims 4 and 17 depend from claim 1

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and patentably distinguish over the **Beller et al.** reference for the same reasons set forth above with respect to claim 1.

Reconsideration and withdrawal of the rejection under §102(e) are respectfully requested.

Claim rejections - 35 U.S.C. § 103

Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Beller** in view of **Merzenich et al.** (USP 5,813,862). For the reasons set forth in detail below, this rejection is respectfully traversed.

Claim 16 depends from claim 1. It is submitted that **Merzenich et al.** do not disclose or suggest the above-noted features missing from the **Beller et al.** reference. Therefore, **Merzenich et al.** do not alleviate the deficiencies of **Beller et al.** and claim 16 is allowable over the combination of references for the same reasons set forth above with respect to claim 1.

Reconsideration and withdrawal of the rejection under §103 are respectfully requested.

CONCLUSION

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

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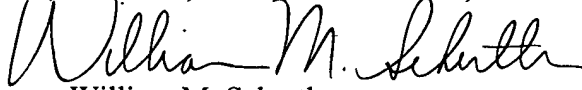
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Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, written over the printed name.

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